

Applicant : Hugh R. Sharkey et al.
Serial No. : 09/895,609
Filed : June 29, 2001
Page : 8 of 10

Attorney's Docket No.: 14170-051002 / 25-31-0067

REMARKS

Claims 41-45, 47-50, 60-76, and 91-92 were examined in the Office Action mailed August 11, 2003. Applicants have amended claims 41, 60-62, 74, and 75; cancelled claim 66; and added new claims 93-103. Accordingly, claims 41-45, 47-50, 60-65, 67-76, and 91-103 are presented for consideration.

Claims 41-44, 47-50, 60, 61, 63-65, 67-69, 71-76, 91, and 92 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Parins (5,197,963). Of these claims, claims 41 and 60 are independent and the remaining claims depend therefrom. Applicants submit that the rejection is moot in light of the amendments to claims 41 and 60.

With respect to claim 41, Parins does not disclose or suggest at least that "each of the first and second electrodes has a portion extending across the aperture, the extending portions being substantially parallel" (claim 41). The Examiner's rejection states in part: "The electrodes extend across a portion of the aperture, extend in parallel relationship, and form a partial loop or hook shape (Figure 4)." Contrary to the Examiner's assertion, the portions of the two electrodes 96 and 98 that extend across an aperture, i.e., the curved ends which extend partially across the distal region defined by sheath 100 in Fig. 4, are spaced in a non-parallel manner for at least the reason that the curved ends lie in the same plane and are not everywhere equidistant. While portions proximal of the curved ends are parallel, these portions do not extend across an aperture.

With respect to claim 60, Parins does not disclose or suggest at least an instrument having "an active electrode" and "a return electrode" with "the active electrode extending across the entire lumen opening" (claim 60). Rather, Parins describes an embodiment having two electrodes 96 and 98 in which neither electrode 96 or 98 extends across port 106 at all, and in which each electrode 96 and 98 extends only partially across the distal region defined by sheath 100 in Fig. 4.

Therefore, for at least the reasons discussed above, claims 41 and 60 and their dependent claims are patentable over Parins.

Claims 41-43, 45, 47-50, 60, 62-63, 65-68, 70-71, 73-74, and 91 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Blewett et al. (6,106,521). Of these claims, claims 41 and

Applicant : Hugh R. Sharkey et al.
Serial No. : 09/895,609
Filed : June 29, 2001
Page : 9 of 10

Attorney's Docket No.: 14170-051002 / 25-31-0067

60 are independent and the remaining claims depend therefrom. Applicants submit that the rejection is moot in light of the amendments to claims 41 and 60.

With respect to claim 41, Blewett et al. do not disclose or suggest at least "the extending portions being substantially parallel" (claim 41). Rather, Blewett et al. describe electrodes 38 that have an angle of divergence of at least 30 degrees (col. 6, line 66 – col. 7, line 2) and are, therefore, not substantially parallel (see Figs. 14 and 16).

With respect to claim 60, Blewett et al. do not disclose or suggest at least "a line in fluid communication with the lumen" (claim 60). Rather, in Blewett et al. any line in fluid communication would have to connect to a channel port 116, which connects to a working channel 114 for fluid transfer (col. 6, lines 8-17). However, working channel 114 cannot be a lumen as recited in claim 60 because electrodes 38 do not extend even partially across the opening of working channel 114 (see Fig. 14), whereas the recited "active electrode ... extend[s] across the entire lumen opening" and the recited "return electrode ... extend[s] at least partially across the lumen opening" (claim 60).

Therefore, for at least the reasons discussed above, claims 41 and 60 and their dependent claims are patentable over Blewett et al.

Claims 75-76 and 92 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blewett et al. in view of Parins. Applicants submit that the rejection is moot in light of the amendments to claims 41 and 60. With respect to claim 92, which depends from claim 41, as discussed above neither Blewett et al. nor Parins discloses or suggests at least "the extending portions being substantially parallel" (claim 41). With respect to claims 75-76, both of which depend from claim 60, Applicants submit that Parins does not overcome the deficiencies of Blewett et al. Blewett et al. does not describe an instrument having a line in fluid communication with a lumen where an electrode extends across an entire lumen opening that is in communication with the lumen, and Parins, similarly, does not describe an electrode extending across an entire lumen opening. For at least these reasons, Applicants submit that claims 41 and 60 and their dependent claims are patentable over Blewett et al. in view of Parins.

Applicants do not acquiesce to the examiner's description of the prior art and mention, by way of example, that neither Parins nor Blewett et al. disclose or suggest "an edge suitable to perform a mechanical scraping operation and an electrosurgical operation" (claim 73).

Applicant : Hugh R. Sharkey et al.
Serial No. : 09/895,609
Filed : June 29, 2001
Page : 10 of 10

Attorney's Docket No.: 14170-051002 / 25-31-0067

Enclosed is a check for \$600, including the IDS fee (\$180) and the Petition for Extension of Time fee (\$420). Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,



Brian J. Dorini
Reg. No. 43,594

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

40197825.doc